

REMARKS

Applicant has carefully reviewed this Application in light of the Office Action mailed February 23, 2004. At the time of the Office Action, Claims 41-48 and 56-58 were pending. Claims 1-18, 49-55 and 59-61 were previously canceled by Applicant. Claims 19-40 were previously withdrawn due to an election/restriction requirement. Claims 41-48 and 56-58 stand rejected under § 103(a). Applicant has amended Claim 41 to further define various features of Applicant's invention. Applicant makes no admissions that these amendments were necessary or made as a result of any prior art. Applicant has canceled Claim 42 without prejudice or disclaimer. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 103

Claims 41-48 and 56-58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,629,186 issued to Robert D. Yasukawa et al. (hereinafter "Yasukawa") in view of U.S. Patent 4,923,901 issued to Hubert Koester et al. (hereinafter "Koester").

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Claim 41, as amended, recites a diagnostic device comprising, among other elements, "a rigid three-dimensional porous material manufactured from alumina, silica and a fusion source."

Applicant respectfully submits that the cited references fail to disclose every element of Applicant's invention. Further, there is no motivation, suggestion or teaching to combine Yasukawa or Koester. Yasukawa or Koester, alone or in combination, fail to teach a diagnostic device comprising "a rigid three-dimensional porous material manufactured from alumina, silica and a fusion source" as recited by amended Claim 41. Applicant submits that Koester only mentions using aluming or silica in one sentence in the patent (Col. 1, Lines 23-29). Applicant further submits that Koester fails to disclose, suggest, or teach combining aluming and silica. The cited references fail to disclose the recited limitations and cannot render obvious amended Claim 41.

Given that Claims 43-48 and 56-58 depend from allowable Claim 41, Applicant respectfully submits that Claims 43-48 and 56-58 are allowable. As such, Applicant respectfully requests that the Examiner withdraw the rejections and allow Claims 41, 43-48 and 56-58.

Claims 41-48 and 56-58 additionally stand rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 96/24631 issued to Mark B. Lyles et al. (hereinafter "Lyles") in view of Koester.

Claim 41, as amended, recites a diagnostic device comprising, among other elements, "a rigid three-dimensional porous material manufactured from alumina, silica and a fusion source."

Applicant respectfully submits that the cited references fail to disclose every element of Applicant's invention. Further, there is no motivation, suggestion or teaching to combine Lyles or Koester. Lyles or Koester, alone or in combination, fail to teach a diagnostic device comprising "a rigid three-dimensional porous material manufactured from alumina, silica and a fusion source" as recited by amended Claim 41. Applicant further submits that Koester fails to disclose, suggest, or teach combining aluming and silica. The cited references fail to disclose the recited limitations and cannot render obvious amended Claim 41.

Given that Claims 43-48 and 56-58 depend from allowable Claim 41, Applicant respectfully submits that Claims 43-48 and 56-58 are allowable. As such, Applicant respectfully requests that the Examiner withdraw the rejections and allow Claims 41, 43-48 and 56-58.


CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of Claims 41, 43-48 and 56-58, as amended.

A check in the amount of \$55.00 is enclosed for the One Month Petition for Extension of Time Fee. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 02-0383 of Baker Botts L.L.P.

If there are any matters concerning this application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2580.

Respectfully submitted,  
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